

DCP/REF  
# 367  
EXHIBIT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Confirmation No. 3265

Appl. No. : 09/939,591

Applicant : Y. KIYOTOKI et al

Filed : August 28, 2001

Title : CORROSION-RESISTING AND WEAR-RESISTING  
ALLOY AND DEVICE USING THE SAME

TC/AU : 1742

Examiner : J. Sheehan

Docket No.: NIP-239

Customer No.: 24596

Director of the U.S. Patent  
and Trademark Office

Mail Stop 16

P.O. Box 1450

Alexandria, VA 22313-1450

REQUEST FOR REFUND

Sir:

Applicants request a refund in the above-identified application due to an error on the part of the Patent Office.

On November 22, 2004, Applicants filed an Information Disclosure Statement. The Information Disclosure Statement was filed within three months of the discovery date. A copy of the Foreign Patent Office communication of October 21, 2004 citing the reference cited in the IDS is enclosed as evidence that the IDS was filed within the three-month certification period.

BEST AVAILABLE COPY

NIP-239

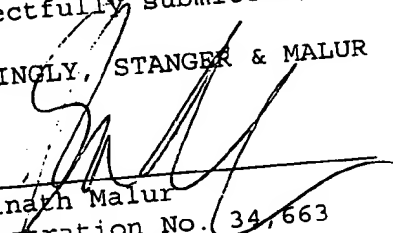
Appl. No. 09/939,591  
Request for Refund dated January 7, 2005

However, the Applicants' representative's Monthly Statement of Account for December 2004 (copy enclosed) indicates that an Information Disclosure Statement fee was charged to the deposit account on December 15, 2004, even though there should have been no charges for the Information Disclosure Statement filed.

Please credit a refund in the amount of \$180.00 to the Deposit Account No. 50-1417.

Respectfully submitted,

MATTINGLY, STANGER & MALUR

By   
Shrinath Malur  
Registration No. 34,663  
(703) 684-1120



EPAEPO/OEB  
D-80298 München  
+49 89 2399-0  
523 856 epmu d  
+49 89 2399-4465

Europäisches  
Patentamt

European  
Patent Office

Office européen  
des brevets

Generaldirektion 2

Directorate General 2

Direction Générale 2

Telephone numbers:

Primary Examiner  
(substantive examination)

+49 89 2399-8445

Formalities Officer / Assistant  
(Formalities and other matters)

+49 89 2399-2718

Hackney, Nigel John  
Mewburn Ellis LLP  
York House,  
23 Kingsway  
London WC2B 6HP  
ROYAUME-UNI



Application No. 01 307 257.4 - 2122	Ref. NJHFP5953914	Date 21.10.2004
Applicant Hitachi, Ltd.		

**Communication pursuant to Article 96(2) EPC**

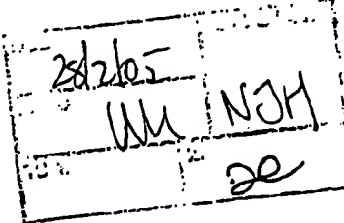
The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period of 4 months

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).



BADCOCK G C  
Primary Examiner  
for the Examining Division

Enclosure(s): 2 page/s reasons (Form 2906)

**BEST AVAILABLE COPY**



Bescheid/Protokoll (Anlage)

Datum  
Date 21.10.2004

Communication/Minutes (Annex)

Blatt  
Sheet 1  
Feuille

Notification/Procès-verbal (Annexe)

Anmelde-Nr.:  
Application No.: 01 307 257.4  
Demande n°:

The examination is being carried out on the following application documents:

Description, Pages

1-47

as originally filed

Claims, Numbers

1-14

received on

29.07.2004 with letter of

27.07.2004

Drawings, Sheets

1/14-14/14

as originally filed

1) Amendments, Art.123

These are based upon content of the the originally filed description, claims and drawings of the application. There is no objection under Art.123(2).

2) Novelty, Art.54(2)

The process of claim 1 is not considered novel with respect to the following document, which is cited in addition to those in the search report.

D5, US5651842, discloses a method of manufacturing a corrosion resistant and wear resistant alloy which is hot forged after casting to break up the cast dendritic structure and evenly distribute eutectic carbides. The method of claim 1 is not novel.

3) Inventive step, Art.56

The process of claim 1 is, in essence, a method of hot working Fe, Ni and/or Co based alloys after casting into slab at a temperature below the solidus temperature. Such a method is not only trivial in the art for these alloys, methods of hot working slabs of these alloy types are well known and have been practised for decades to break up the as-cast dendritic microstructure. Such a microstructure comprises interdendritic carbides, and these have in the past always been broken up and evenly redistributed in the microstructure by hot

BEST AVAILABLE COPY



Bescheld/Protokoll (Anlage)

Datum  
Date  
21.10.2004

Communication/Minutes (Annex)

Blatt  
Sheet  
Feuille 2

Notification/Procès-verbal (Annexe)

Anmelde-Nr.:  
Application No.: 01 307 257.4  
Demande n°:

working. Such a redistribution of primary and eutectic carbides in the microstructure was, very early on, found to have beneficial effects for all manner of alloy properties, including the physical properties such as hardness, tensile strength and corrosion resistance, the latter due to the absence of corrosion by galvanic cell corrosion caused by large unevenly distributed second phases, such as carbides and by chromium depletion during cooling/solidification into the as-cast structure.

The features in the dependent claims would appear neither novel nor inventive.

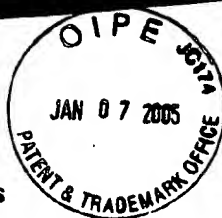
4) Remarks

The present set of claims is not allowable. The applicant should expect a refusal of the application.

BEST AVAILABLE COPY



# United States Patent and Trademark Office



Return To:  
USPTO  
Home  
Page  
Finance  
Online  
Shopping  
Page

## Deposit Account Statement

Requested Statement Month:

December 2004

Deposit Account Number:

501417

Name:

MATTINGLY STANGER & MALUR, P.C.

Attention:

1800 DIAGONAL ROAD, SUITE 370

Address:

ALEXANDRIA, VA

City:

VA

State:

22314

Zip:

DATE	SEQ	POSTING REF TXT	ATTORNEY DOCKET NBR	FEE CODE	AMT	BAL
12/01	220	09814693	NIT-272	1202	\$14.00	\$6,141.00
12/06	128	5847013		8021	\$40.00	\$6,101.00
12/06	129	5962347		8021	\$40.00	\$6,061.00
12/06	130	6074958		8021	\$40.00	\$6,021.00
12/06	131	6309980		8021	\$40.00	\$5,981.00
12/07	26	10369650	H-1088	1201	\$88.00	\$5,893.00
12/09	30	09658025	NIP-204	1252	\$180.00	\$5,713.00
12/09	31	10091405	H-1030	1253	\$40.00	\$5,673.00
12/09	35	E-REPLENISHMENT		9203	-\$10,000.00	\$15,673.00
12/09	97	10270515	NUM-100-02	1814	\$20.00	\$15,653.00
12/10	309	10886646	274-43692X00	8007	\$20.00	\$15,633.00
12/10	577	5847013		8021	\$40.00	\$15,593.00
12/10	578	5962347		8021	\$40.00	\$15,553.00
12/10	579	6074958		8021	\$40.00	\$15,513.00
12/10	580	6309980		8021	\$40.00	\$15,473.00
12/15	4	09939591	NIP-239	1806	\$180.00	\$15,293.00
12/15	8	09599005	520.38691X00	1252	\$20.00	\$15,273.00
12/15	46	11009449	ASA-1022-04	1311	\$200.00	\$15,073.00
12/21	755	09305452	648.37184X00	8021	\$40.00	\$15,033.00
12/22	57	09764377	500.39531X00	1806	\$180.00	\$14,853.00
12/22	389	09593956	ASA-888	1501	\$30.00	\$14,823.00
12/27	1	10704849	H-420-09	1253	\$1,020.00	\$13,803.00
12/27	48	11016814	MEI-110	1202	\$40.00	\$13,763.00
12/28	27	07106409	NES 2 010	1553	-\$3,100.00	\$16,863.00
12/28	28	4832200		1553	\$3,100.00	\$13,763.00
12/29	155	11006636	500.35345CX3	1111	\$10.00	\$13,753.00
12/29	157	11006636	500.35345CX3	1311	\$200.00	\$13,553.00
12/30	20	10927046	KAS-223	1806	\$180.00	\$13,373.00

BEST AVAILABLE COPY

## Deposit Account Statement

12/30 30 6247253	9204	-\$20.00	\$13,393.00
START BALANCE	SUM OF CHARGES	SUM OF REPLENISH	END BALANCE
\$6,155.00	\$5,882.00	\$13,120.00	\$13,393.00

[Need Help?](#) | [Return to USPTO Home Page](#) | [Return to Finance Online Shopping](#)

BEST AVAILABLE COPY



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/939,591  
Applicant : Y. KIYOTOKI et al  
Filed : August 28, 2001  
Title : CORROSION-RESISTING AND WEAR-RESISTING  
ALLOY AND DEVICE USING THE SAME  
TA/AU : 1742  
Examiner : J. Sheehan  
Docket No.: NIP-239  
Customer No.: 24956

Commissioner for Patents  
Mail Stop DD  
P.O. Box 1450  
Alexandria, VA 22314-1450

**INFORMATION DISCLOSURE STATEMENT (IDS)**  
**UNDER § 1.97 AND § 1.98**

Sir:

1. This IDS should be considered:

(a) when filed within three months of the filing date of the present application, or within three months of the filing date of the National Stage as set forth in § 1.491 in an international application, or before the mailing date of a first Office Action on the merits, whichever occurs last;

(b) when filed before the mailing date of either a Final Rejection under § 1.113 or a Notice of Allowance under § 1.311, whichever occurs first and when 1(a) does not apply. For this purpose, there is included herein either a certification in section 4 below (included when indicated by a marked box), or a fee of \$180.00 (a Credit Card Payment Form in the amount of \$180.00 is enclosed, or if not see section 5 below);

(c) when filed prior to the payment of the Issue Fee, when 1(a)-(b) do not apply, and when a certification is included in section 4 below (included when indicated by a marked box); then the Applicant(s) hereby petition(s) and